

1 The opinion in support of the decision being entered today is *not* binding  
2 precedent of the Board

3  
4 UNITED STATES PATENT AND TRADEMARK OFFICE  
5

6  
7 BEFORE THE BOARD OF PATENT APPEALS  
8 AND INTERFERENCES  
9

10  
11 *Ex parte* MARK STUTLER  
12

13  
14 Appeal 2006-3322  
15 Application 10/081,156  
16 Technology Center 3600  
17

18  
19 Decided: August 31, 2007  
20

21  
22 *Before* MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and  
23 DAVID B. WALKER, *Administrative Patent Judges*.

24  
25 CRAWFORD, *Administrative Patent Judge*.  
26

27  
28 DECISION ON APPEAL  
29

30 STATEMENT OF CASE

31 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection  
32 of claims 1, 6, 13, and 15.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b)  
33 (2002).

34 Appellant invented a reusable fresh masonry wall protection device  
35 (Specification 1).

---

<sup>1</sup> Appellant does not appeal the rejection of claims 16 and 17 (Brief 1).

1 Claim 1 under appeal reads as follows:

2 1. A reusable fresh masonry wall protection device  
3 for rapidly protecting a newly laid block or brick wall  
4 from inclement weather and providing temporary  
5 reinforcement for the upper layer of newly laid blocks or  
6 bricks, said newly laid wall having a width W  
7 comprising:

8 a thin plastic channel element having a top panel  
9 member and a pair of parallel side panel members,  
10 said top panel member having width greater  
11 than W and a smooth, flat inner face which is  
12 adapted to engage the topmost surface of said  
13 newly laid block or brick wall,  
14 said parallel side panel members being  
15 springy and angled inwardly so that they engage  
16 the newly laid block or brick wall, and have lower  
17 ends which angle outwardly to form a guideway  
18 for installing said protection device on said newly  
19 laid block or brick wall.

20  
21 The Examiner rejected claims 1 and 6, under 35 U.S.C. § 112,  
22 paragraph 2.<sup>2</sup>

23 The Examiner rejected claims 1, 6, and 15 under 35 U.S.C. § 102(b)  
24 as being anticipated by Carlberg.

25  
26 The Examiner rejected claims 1, 6, 13, and 15 under 35 U.S.C.  
27 § 102(b) as being anticipated by Pulsipher.

28  

---

<sup>2</sup> The Appellant does not appeal this rejection as it relates to claims 16 and 17.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Carlberg	US 5,479,750	Jan. 2, 1996
----------	--------------	--------------

Pulsipher	US 5,772,185	Jun. 30, 1998
-----------	--------------	---------------

Appellant contends that the rejection of claims 1 and 6 under 35 U.S.C. § 112, paragraph 2 is moot.

Appellant contends that the device of Carlberg is not a thin reusable device that has ends that are angled outward.

Appellant contends that Pulsipher is not reusable, not for newly laid brick and does not engage the top surface of the brick wall.

## ISSUES

Whether Appellant has shown (1) that the Examiner erred in holding that claims 1 and 6 fail to comply with the requirements of 35 U.S.C. § 112, second paragraph or (2) that this rejection is moot.

Whether Appellant has shown that the Examiner erred in finding that Carlberg discloses a thin reusable device that has ends angled outward.

Whether Appellant has shown that the Examiner erred in finding that Pulsipher discloses a reusable device that is disposed to engage the top surface of a brick wall.

## FINDINGS OF FACT

Appellant's Specification discloses a channel element 10 that may be used to protect a block or brick wall from the effects of weather (Specification p. 8). The channel element 10 is made of a material that is

1 thin enough that it can be cut with a pair of scissors along score lines  
2 (Specification pp. 12 to 13).

3 Carlberg discloses a channel element 10 that is capable of protecting a  
4 newly laid block or brick wall. The channel element 10 is comprised of a  
5 flexible plastic material of moderate thickness which is scored to facilitate  
6 snapping to achieve a channel element of pre-determined length (col. 3, ll. 4  
7 to 8). The channel element 10 may also be formed of a thin metal (col. 4, ll.  
8 42 to 43). The channel element 10 of Carlsberg also includes lower ends 30  
9 which angle outwardly (Figure 1). The channel element 10 is capable of  
10 being reused after an initial placement on a block or brick wall by placing  
11 the channel element 10 on a subsequent block or brick wall.

12 Pulsipher discloses a channel element 10 that is disposed on the top of  
13 a block or brick wall to protect it from rain and weather (col. 1, ll. 6 to 16).  
14 The channel element 10 engages a portion of the topmost surface 48 of the  
15 block or brick wall (col. 4, ll. 59 to 61; Figure 2). The channel element 10 is  
16 capable of being reused after an initial placement on a block or brick wall by  
17 placing the channel element 10 on a subsequent block or brick wall.

18 It is well known when attaching a channel element to an edge with a  
19 friction fit to start by seating one edge and advancing to the opposite edge.

20  
21 DISCUSSION

22 Rejection under 35 U.S.C. § 112.

23 We initially note that Section 112, second paragraph, is  
24 satisfied if a person skilled in the field of the invention would reasonably  
25 understand the claim when read in the context of the Specification. *Marley*

1 *Mouldings Ltd. v. Mikron Indus., Inc.*, 417 F.3d 1356, 1359, 75 USPQ2d  
2 1954, 1956 (Fed. Cir. 2005) (citing *Union Pac. Res. Co. v. Chesapeake*  
3 *Energy Corp.*, 236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed. Cir. 2001)  
4 (the definiteness requirement set forth in § 112, ¶ 2 "focuses on whether  
5 those skilled in the art would understand the scope of the claim when the  
6 claim is read in light of the rest of the specification"); *Miles Labs., Inc. v.*  
7 *Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (if the  
8 claims "reasonably apprise those skilled in the art of the scope of the  
9 invention, § 112 demands no more"); *In re Moore*, 439 F.2d 1232, 1235, 169  
10 USPQ 236, 238 (CCPA 1971) (the indefiniteness inquiry asks whether the  
11 claims "circumscribe a particular area with a reasonable degree of precision  
12 and particularity").

13       The term "thin" is a term of degree. When a word of degree is used, it  
14 is necessary to determine whether the specification provides some standard  
15 for measuring that degree. *See Seattle Box Company, Inc. v. Industrial*  
16 *Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed.  
17 Cir. 1984).

18       The Examiner has determined that the term "thin" in claims 1 and 6 is  
19 not defined by the claims and the Specification does not provide a standard  
20 for ascertaining the requisite degree so that one of ordinary skill in the art  
21 would not be reasonably apprised of the scope of the invention.

1       The Appellant contends that this rejection is moot in view of an  
2 amendment filed after the final rejection. However, the use of the term  
3 “thin” remains in claim 1 and, by dependence, in claim 6 and as such the  
4 Examiner is correct that this rejection is not moot.

5       Appellant has not advanced arguments in response to this rejection.  
6 Therefore, we summarily sustain this rejection.

7  
8 Rejection based on Carlberg

9       We now address the Examiner’s rejection of claims 1, 6, and 15 under  
10 35 U.S.C. § 102(b) as being anticipated by Carlberg.

11       We recognize the inconsistency implicit in our holding that claims 1  
12 and 6 do not comply with the requirements of 35 U.S.C. § 112, second  
13 paragraph, as failing to particularly point out and distinctly claim the  
14 invention with a holding that these claims are anticipated under 35 U.S.C.  
15 § 102. Normally, when substantial confusion exists as to the interpretation  
16 of a claim and no reasonably definite meaning can be ascribed to the terms  
17 in a claim, a determination as to patentability under 35 U.S.C. § 102 is not  
18 made. *See In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96  
19 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496  
20 (CCPA 1970). However, in this instance, we consider it to be desirable to  
21 avoid the inefficiency of piecemeal appellate review. *See Ex parte Ionescu*,  
22 222 USPQ 537, 540 (Bd. App. 1984). Therefore, in the interest of judicial  
23 economy, we interpret the term “thin” to mean a material that is thin enough  
24 to be severed along score lines (See Specification p.13).

1       We will sustain this rejection because we are not persuaded by  
2   Appellant's arguments. Carlberg discloses a channel member that is  
3   comprised of plastic material that is thin enough to be severed along a score  
4   line and as such is thin as broadly claimed.

5       Secondly, although Carlberg does not disclose that the channel  
6   member is reused or that the channel member is placed on a newly laid brick  
7   wall, the Carlberg channel member is inherently capable of being placed on  
8   a newly laid brick wall or reused. It is well settled that apparatus claims  
9   must distinguish over prior art apparatus by the structure defined by the  
10   claims, and not by a process or function performed by the apparatus. A prior  
11   art apparatus having the same structure as a claimed apparatus renders a  
12   claimed apparatus unpatentable under Section 102 as long as it is capable of  
13   performing the claimed process or function. *In re Yanush*, 477 F.2d 958,  
14   959, 177 USPQ 705, 706 (CCPA 1973); *Ex Parte Masham*, 2 USPQ2d  
15   1647, 1648 (Bd. Pat. App. & Int. 1987).

16  
17   Rejection based on Pulsipher.

18       We will sustain this rejection because we are not persuaded by the  
19   arguments of the Appellant. In this regard, although Pulsipher does not  
20   specifically disclose that the channel member 10 is reusable or that it can be  
21   used on a newly laid brick wall, the channel member is inherently capable of  
22   being reusable or being used on a newly laid brick wall. In addition, we  
23   agree with the Examiner that the inner face of the channel member does  
24   indeed engage the topmost surface of the brick wall.

In regard to claim 13, we note that the Appellant has not addressed the finding of the Examiner that the specific method claims are inherent and well known but rather argues only that the specific method steps of this claim are not taught by Pulsipher. We agree with the Examiner (Answer 9) that it is well known when attaching a channel element to the top of a wall or other structure so as to have a friction fit to start by seating one edge and then seat the opposite edge and the Appellant has not disputed the Examiner's contention. Therefore, we will sustain the rejection as it is directed to claim 13.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

**AFFIRMED**

jlb

Law Office of Jim Zegeer  
Suite 108  
801 North Pitt Street  
Alexandria VA 22314